

REMARKS AND DISCUSSION

Upon entry of the present Amendment-A, claims 1, 6-11, 13 and 15 remain pending in the application, of which claims 1, 9, 13 and 15 are independent.

After careful consideration of the objections and rejections set forth in the Office Action, applicant respectfully submits that as amended, claims 1 6-11, 13 and 15 patentably distinguish over the art of record. Applicant respectfully submits that all of the above amendments are fully supported by the original application. Applicant also respectfully submits that the above amendments do not introduce any new matter into the application. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 USC §112

On page 2 of the Office Action, the Examiner stated “Claims 12-5 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.” As best understood, applicant believes that the Examiner meant that claims 2-5 were rejected under 35 U.S.C 112, first paragraph, as failing to comply with the written description requirement. Applicant requests clarification if this understanding is not correct.

Applicant's Response

Contrary to the Examiner's assertion, the first paragraph of Section 112 is directed to the specification, rather than to the claims, and requires an enabling disclosure. Therefore, it is not consistent with the language the statute to reject claims under the first paragraph of Section 112.

The first paragraph of 35 U.S.C. §112 reads as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicant respectfully submits that the specification of the present application contains an enabling disclosure, and is in full compliance with the requirements set forth in the first paragraph of 35 U.S.C. 112.

Further, applicant respectfully points out that in considering whether there is 35 U.S.C. 112, ¶ 1 support for a claim limitation, the examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) (drawings); *In re Wolfensperger*, 302 F.2d 950, 955-957, 133 USPQ 537, 541-543 (CCPA 1962) (drawings).

Applicant has amended claim 1 by the present amendment to include selected limitations from claims 2 and 3, and applicant has canceled claims 2-5 herein. Applicant therefore submits that the rejection of claims 2-5 under 35 USC 112, first paragraph, has been overcome.

Further in the above-identified Office Action, the Examiner also rejected claims 2, 7 and 16 under 35 USC 112, second paragraph, as indefinite. Specifically, the Examiner referred to the term “the lower end of the insert member or socket member” and “the base of the socket member or the insert member” as lacking antecedent basis in claim 2. The Examiner also took the position that claim 7 was indefinite in that the structure of something that is a “dual durometer material” is unclear, and stated that in claim 16, the phrase “the fingers of the insert member” lacked antecedent basis.

Applicant has made some amendments to the claims to provide antecedent basis for selected terms, and has canceled claim 16. In addition, applicant points out that certain features such as a "lower end" or the like would be understood by those in the art without requiring embellishment.

Upon careful consideration and in light of the above amendments, applicant respectfully submits that the language of the present claims would be clearly understood by persons skilled in the art, especially when considered in light of the specification disclosure, and are adequately definite within the guidelines of 35 USC 112, second paragraph.

Accordingly, it is respectfully submitted that the Examiner's rejection has been overcome, and applicant requests reconsideration and withdrawal of the Examiner's rejection of claim 7 under 35 USC 112, second paragraph.

Claim Rejections — 35 USC §102

Also on page 2 of the Office Action, the Examiner rejected claims 1, 2 and 15 under 35 U.S.C. 102(b) as anticipated by Goldman (U.S. 5,118,106). The Examiner stated that Goldman shows a socket member with tracks, and an insert member with fingers extending from a reduced diameter hub.

Applicant's Response

Upon careful consideration applicant respectfully traverses such rejection because applicant's invention is clearly patentably distinct over Goldman. While Goldman does disclose a two-part insert, the locking structure of Goldman is significantly different from applicant's structure, as currently claimed.

The Standard for Anticipation

In the case of *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F. 3d 1461 (CAFC 1997), the Court of Appeals for the Federal Circuit stated:

“For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art (citation omitted). ‘The (prior art) reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it’ (citations omitted). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.”

The above-quoted passage is consistent with many previous cases of the Federal Circuit and with MPEP 2131, which reiterate the rule that **in order to anticipate a claim, a reference must teach every element of the claim.**

Applicant respectfully submits that Goldman does not disclose each and every element of applicant’s claimed invention.

In an effort to expedite prosecution of the present application, applicant has amended claims 1, 9, 10, 13 and 15, in order to more clearly define the novel structure of applicant’s insert apparatus and method of use.

These amendments to applicant’s claims clearly distinguish applicant’s invention over that of Goldman. Specifically, Goldman fails to teach applicant’s claimed structure, including ramped locking tracks formed on the underside of a socket member, in combination with radially extending fingers at a lower end of an insert member, and in which the insert member is nestingly insertable into a hollow bore of the socket member and is twistable in the socket member, when fully inserted therein, to engage locking structures to temporarily and removably lock the insert member in the socket member.

Based on the foregoing, the rejection of claims 1 and 15 under 35 U.S.C. 102(b) as anticipated by Goldman has been overcome, and it is respectfully requested that the rejection be reconsidered and withdrawn.

Claim Rejections – 35 USC §103

On page 3 of the Office Action, the Examiner rejected claims 3-5, 9-14 and 16 under 35 U.S.C. 103(a) as unpatentable over Goldman in view of Natoli (U.S. 4,029,953).

Also on page 3 of the Office Action, the Examiner rejected claims 6-8 under 35 U.S.C. 103(a) as unpatentable over Goldman in view of Natoli and further in view of Immen 712,192.

The Examiner asserted that, in his view, “twist and lock mechanisms for securing elements together using a cam surface having a track are known”, without providing any documentation or other supporting evidence for this statement. It appears that the Examiner is taking official notice of this assertion.

The applicant respectfully traverses this ground of rejection, and respectfully challenges the Examiner’s assertion as not properly officially noticed, and not properly based on common knowledge.

The Applicant respectfully requests that the Examiner either withdraw the rejection or produce some documentary evidence supporting his position, and further requests that the Examiner reconsider and withdraw the rejection, in the absence of a showing of specific documents containing all of the claimed features of applicant’s invention, as well as motivation in the art to combine those specific documents in a way that teaches applicant’s invention.

Guidelines Regarding Official Notice

The USPTO's guidelines regarding when official notice is proper have recently been revised, and are set out in MPEP 2144.03. Applicant reproduces pertinent sections of MPEP 2144.03 hereinbelow, in an effort to assist the Examiner.

2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art

In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied.

PROCEDURE FOR RELYING ON COMMON KNOWLEDGE OR TAKING OFFICIAL NOTICE**A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion**

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known (emphasis added). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence, provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. In *re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. In *re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); In *re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470,

474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated " 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation..The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.").

B. If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). In certain older cases, official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common

knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). **If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).**

(end of quoted MPEP material)

Applicant respectfully suggests that the Examiner's assertion that "twist and lock mechanisms for securing elements together using a cam surface having a track are known", fails to meet the standard set out in MPEP 2144.03. The purported 'facts' noticed by the Examiner are not well known in applicant's claimed context and combination; in fact, it is applicant's understanding and belief that they are unknown in such context and combination.

Applicant therefore requests reconsideration and withdrawal of the Examiner's assertion that "twist and lock mechanisms for securing elements together using a cam surface having a track are known", or, in the alternative, demands documentary support for such assertion.

The Standard for Obviousness under Federal Circuit Law

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to private patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

The U.S. Court of Appeals for the Federal Circuit has said that a reference must be

viewed in its entirety, *Gore v. Garlock*, 220 U.S.P.Q. 303 (CAFC 1983) and that it is impermissible to use the claims as a frame, and the references as a mosaic, to pick and choose selected pieces, out of context, to reconstruct the invention, *Northern Telecom v. Datapoint*, 908 F.2d 931 (CAFC 1990).

The U.S. Court of Appeals for the Federal Circuit has also said that that in order to combine references, the Examiner must show some motivation, suggestion, or teaching of the desirability of making the combination, *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (CAFC 1999); and that the use of hindsight, in evaluating patentability, is improper, *In re Werner Kotzab*, 55 U.S.P.Q. 2d 1313 (CAFC 2000); *Gore v. Garlock*, *supra*.

Specifically, in *Kotzab*, *supra*, the CAFC stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.*

Most, if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (citations omitted).

Applicant respectfully suggests that the Examiner appears to be evaluating applicant's invention using improper hindsight, picking and choosing selected portions of the references and combining those selected portions with 'facts' which the Examiner officially notices, to

reconstruct a mosaic of applicant's invention. Applicant respectfully suggests that such an approach is not consistent with the standards set out in the above-quoted cases of the CAFC.

Analogous and Non-analogous art

The Court of Appeals for the Federal Circuit has stated that those in a position to evaluate patentability should not consider references that are "too remote to be treated as prior art." *In re Clay*, 966 F.2d 656, 658 (Fed. Cir.1992) (quoting *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n. 9 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052, 107 S.Ct. 2187, 95 L.Ed.2d 843 (1987)). The determination of whether a prior art reference is within the inventor's field or an analogous art is a factual issue, *In re Clay*, supra. Courts consider two factors in determining whether prior art is analogous: "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 966 F.2d at 658-59; *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). See also *In re GPAC Inc.*, 57 F.3d 1573, 1577-1579 (Fed. Cir. 1995).

Applicant respectfully submits that Natoli is non-analogous art in relation to the present invention, since Natoli is not from the same field of endeavor as the applicant, and since Natoli is directed to improvements in electric lamp sockets, and is not reasonably pertinent to the problem of providing improved thumb and finger inserts for bowling balls.

Applicant therefore requests reconsideration and withdrawal of the rejection of applicant's claims under 35 USC 103 based on Goldman in view of Natoli.

Applicant's Response

Upon careful consideration applicant respectfully traverses the Examiner's rejection of

applicant's claims under section 103, and submits that each of the pending claims are clearly patentably distinct over the Goldman, Natoli and Immen references (whether considered singly or in combination), for those reasons as applied to claim 1 above which are not overcome by any additional teachings of Natoli or Immen.

Applicant further notes that the language of the claims has been amended in an effort to expedite prosecution of the application. As amended, applicant submits that the claims are patentably distinct over the art of record.

Based on the foregoing, applicant requests reconsideration and withdrawal of the Examiner's rejection of claims 3-5, 9-14 and 16 under 35 U.S.C. 103(a) as unpatentable over Goldman in view of Natoli, and also the Examiner's rejection of claims 6-8 over Goldman in view of Natoli and further in view of Immen.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are allowable over all of the references of record, whether considered singly or in combination. Applicant requests reconsideration and withdrawal of the rejections of record, and allowance of the pending claims.


The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not fully convinced of all of the claims now in the application, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

Favorable reconsideration is respectfully requested.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the United States Patent and Trademark Office on October 28, 2005.



William Blackman

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